

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

References of record in the parent application

Applicant respectfully requests the Examiner's consideration of references already of record in the application which are acknowledged to be in the file by the "NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" dated July 11, 2003, and which are mentioned in the international search report established in the international application (PCT/EP00/06577). To ensure that the list of documents will be printed on the face of any patent issuing from this application, applicant submits herewith a form PTO-1449 listing these references. Should these references not be in the application file at the Patent Office, the Examiner is invited to contact Applicant's representative for new copies.

Claim objections

The claims presently stand rejected for certain informalities. Specifically, the examiner notes that use of figure references in the claims is inconsistent. Claims 1-21 have been amended to remove all figure references, thereby obviating this objection.

The examiner also refers to certain language recited in the claims as "intended use." The claims have been amended to better describe the present invention. However, it is respectfully submitted that the language that the examiner refers to recites aspects and characteristics of the invention and certain of its component parts, and not an intended use of the invention. In view of the amendments made, and the recitation of characteristics of the invention and its component parts, rather than an intended use of the invention, withdrawal of this rejection is respectfully requested.

Rejection of claim 16 under 35 U.S.C. § 112, first paragraph

Claim 16 presently stands rejected as failing to comply with the enablement requirement. This rejection is respectfully traversed for the following reasons.

Claim 16 recites a terminal storage unit and/or processor unit that is partly stored on a portable data carrier. While the examiner contends that “to one of ordinary skill computer memory and a processor are independent and stand-alone structures and would not have a part of its structure in a terminal and the other portion on a portable data carrier.” It is respectfully submitted, however, that one of ordinary skill in the art would recognize that a computer memory and a processor *are not* necessarily independent and stand-alone structures, and that computer memory and a processor are not necessarily monolithic in nature.

On the contrary, although technological advances in integrated circuit fabrication and miniaturization have enabled the fabrication of single-chip processors and single-chip memory components, one of skill in the arts would certainly know that a computer memory may be comprised of plural components, and that a computer processor may be comprised of plural discrete logical units. For example, a computer processor typically includes an arithmetic logic unit (ALU), a control unit, and various registers, interconnected by data buses, control signal buses, or other interconnecting circuitry.

It is respectfully submitted that, especially in large computer systems, and in computer systems of older technology, it is commonplace for a processor to comprise multiple circuit boards, each implementing separate logical components, or even sub-parts of a logical component, of the processor. Similarly, it is respectfully submitted that it is well known for a computer’s memory to be comprised of plural memory chips, circuit boards, or the like.

Therefore, it is respectfully submitted that it is well within the knowledge of persons skilled in the art how to partition memory and processor components into separate parts, and how to provide interconnections such as data or communication buses or the like so that the separate parts may function together.

Accordingly, withdrawal of this rejection is respectfully requested.

Rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph

Claims 1-21 presently stand rejected as being indefinite. The examiner has identified elements in claims 7, 17, 18, and 20 that lack antecedent basis. These claims

have been amended to provide proper antecedent basis for the identified elements. The examiner notes that references in claims 19 and 21 to data “being retransmitted” are unclear because the data was never transmitted in order to allow “retransmission.” Both claims 19 and 21 have been amended to refer to the data “being transmitted.”

The examiner also repeats the assertion, discusses above, that “to one of ordinary skill computer memory and a processor are independent and stand-alone structures and would not have a part of its structure in a terminal and the other portion on a portable data carrier.” As discussed above, it is well within the knowledge of persons skilled in the art how to partition memory and processor components into separate parts, and how to provide interconnections such as data or communication buses or the like so that the separate parts may function together.

Additionally, the examiner notes that claims 1-21 are generally narrative and indefinite, fail to conform with current U.S. practice, and are replete with grammatical and idiomatic errors. Claims 1-21 have been amended to better conform with current U.S. practice, and to correct grammatical and idiomatic errors.

In view of the amendments made and the above comments, withdrawal of this rejection is respectfully requested.

Rejection of claims 1, 2, 4, 6, 9-11, and 13-21 under 35 U.S.C. § 102(e)

Claims 1, 2, 4, 6, 9-11, and 13-21 presently stand rejected as being anticipated by Daly et al (U.S. 5,878,141). This rejection is respectfully traversed for the following reasons.

Independent claims 1, 9, 19, and 21 have been amended to more clearly describe the present invention. The present invention is generally described, as recited in claim 1, as a system for performing a transaction. The system comprises a node computer connected with a plurality of terminals via a terminal network, and each of the terminals includes an apparatus for accessing a portable data carrier. Each terminal is suitable for performing a plurality of different transactions.

When accessed for performing a transaction, a terminal identifies the type of transaction to be performed and checks whether the terminal is suitable to perform the transaction. In other words, the terminal determines whether or not a particular functionality required for the transaction has been installed.

In a case that a further transaction is requested that the terminal is not suitable for (a particular functionality required for the transaction has not yet been installed), suitability for performing the further transaction is provided by the terminal's receiving data via the terminal network to provide the terminal with the particular functionality required for performing the further transaction.

The transaction is then performed in interaction between the node computer and the terminal, the terminal accessing a portable data carrier, and the terminal and node computer each performing partial steps of the transaction.

Claim 9 relates more particularly to the terminal embodied in the system of claim 1, and describes characteristics of the terminal whereby the terminal, when accessed for performing a particular transaction, identifies the type of transaction to be performed, and determines whether the terminal is presently suitable to perform the transaction. If the terminal is not suitable to perform the transaction, a processor unit of the terminal requests data which provides the required functionality for performing the transaction. Once provided with the functionality to perform the transaction, the transaction is performed in conjunction with the node computer and a portable data carrier.

Claims 19 and 21 each relate to a method for performing a transaction wherein a terminal determines whether it is suitable to perform a transaction, and if the terminal is not suitable to perform the transaction, the terminal requests data to provide a required functionality for performing the requested transaction.

It is respectfully submitted that Daly does not anticipate any of independent claims 1, 9, 19, and 21 because Daly does not disclose or suggest a system wherein a terminal, when accessed for performing a transaction, identifies the type of transaction to be performed, checks whether the terminal is suitable to perform the transaction, and if not

suitable to perform the transaction receives data to set up (or install) the functionality required to perform the transaction.

"A claim is anticipated *only if each and every element* as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) (emphasis added). "The *identical invention* must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (emphasis added).

Daly discloses a system for mediating purchases between a purchaser, on one side, and a merchant, on the other side. Purchasers gain access to a network via known telecommunication terminals, and the merchant is represented by a transaction processing unit in connection with a merchant database. The system is used to mediate purchases between purchasers and merchants, and in particular to verify the financial abilities of the purchaser and to derive a common set of payment methods acceptable to the merchant and usable by the purchaser.

However, Daly does not provide any teaching or suggestion that terminals for processing a transaction *can be adapted to carry out* transactions for which the terminal was not configured for at the start of the transaction. On the contrary, it must be noted that a primary focus of Daly is the determination of "a mutually agreeable payment method that is both accepted by the designated merchant and one of the requesting subscriber's personal payment methods" (col. 11, lines 18-20). Daly clearly states that "if there are no available payment method, the purchasing system *denies the transaction* and informs the user" (col. 12, lines 62-64). Thus, Daly provides no capability for the terminal to be reconfigured to perform a transaction that the terminal was not originally configured for.

Furthermore, Daly does not teach that, during processing, transaction data are accessed which are stored on a portable data carrier and which are characteristic for a transaction and needed for processing the transaction.

A basic difference of the present invention as compared to the disclosure of Daly is that the present invention relates to a system in which the terminals are not bound to predetermined functionalities and, therefore, in which the terminals are not adapted to carry out a particular transaction. In the present invention, a particular functionality is provided only after a transaction has been selected (see Fig. 3, steps 100 to 106). The selected transactions, such as bank application, electronic ticket, health insurance application, may differ from one another in respect to both the type of data handled and the steps to be carried out during the transaction. The different transactions solely have in common that they are each intended to access a portable data carrier.

Rejection of claims 3, 5, 7, 8, and 12 under 35 U.S.C. § 103(a)

Claims 3, 5, 7, 8, and 12 presently stand rejected as being unpatentable over Daly in view of Clark (U.S. 5,815,577). This rejection is respectfully traversed for at least the following reasons.

As discussed above, independent claims 1 and 9 are allowable over Daly because Daly does not disclose or suggest each and every limitation set forth in the claims. It is respectfully submitted that Clark, which discloses methods and apparatus for securely encrypting data in conjunction with a personal computer, fails to supplement the deficiencies of Daly with respect to the limitations of claims 1 and 9 discussed above. Therefore, it is respectfully submitted that claims 3, 5, 7, and 8, which depend from claim 1, and claim 12, which depends from claim 9, are allowable over the cited references, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-21 be allowed and the application be passed to issue.

Application No.: 10/030,078
Examiner: C. L. Hewitt II
Art Unit: 3621

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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